



A92621
F110

I hereby Certify that this Correspondence is being deposited with the United States postal service as First Class Main in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 27, 2005.

Martin G. Linihan

Name

Signature

September 27, 2005

Date of Signature

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: John K. Schneider et al

Application No. 09/658,638

Group Art Unit 2621

Filed: September 11, 2000

Examiner: D.M. Dang

For: MOBILE FINGERPRINT SCANNER AND DOCKING STATION

BRIEF IN SUPPORT OF APPEAL

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Herewith is appellant's Brief on Appeal in triplicate together with deposit account authorization for payment of the appeal fee.

REAL PARTY IN INTEREST

Ultra-Scan Corporation is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no pending appeals or interferences related to this application.

09/29/2005 FMETEKI1 00000130 082442 09658638

01 FC:2402 250.00 DA

STATUS OF CLAIMS

Applicant hereby appeals the Examiner's Final Rejection dated January 25, 2005 rejecting claims 1-11.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Rejection of January 25, 2005. The claims in their form as finally rejected by the Examiner are set forth in the attached Appendix.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants' invention provides a system including a mobile or portable fingerprint scanner and one or more docking stations adapted to operatively receive the scanner. Independent claim 1 is directed toward a fingerprint identification system comprising:

- (a) a portable fingerprint scanner which can be hand carried to various locations for obtaining fingerprint images and for storing the images obtained in the scanner for later retrieval (p. 3, lines 29-34 and p. 4, lines 24, 25; 12 - Figs. 1 and 2); and
- (b) at least one docking station at a location spaced from the location where fingerprint images are obtained, the docking station being in the form of a receptacle for receiving the scanner, the docking station being physically separate from the scanner when the scanner is obtaining fingerprint images, the fingerprint images being downloaded from the scanner when the scanner is

received in the docking system (p. 5, lines 10-20; 14 - Figs. 1 and 2).

Independent claim 10 is directed toward a fingerprint identification and security system comprising:

- (a) a portable fingerprint scanner which can be carried on a person and which includes a time of day clock and a port for data communication to and from the scanner (p. 9, lines 7-13; 12¹ - Fig. 3);
- (b) a plurality of docking stations at locations where inspections are to be performed, each of the docking stations being in the form of a receptacle for receiving the scanner, each docking station having a microprocessor and a unique code identification, there being bidirectional data communication between the docking station and the scanner received therein (p. 9, lines 14-31; 14¹, 14¹¹, 14¹¹¹ - Fig 3); and
- (c) a supervisory docking station in the form of a receptacle for receiving the scanner for downloading fingerprint images, times of day and docking station identifications from the scanner received therein (p. 10, lines 9-14; 120 - Fig. 3); and
- (d) whereby when a security person makes a round when he reaches each inspection location he operates the scanner to image his fingerprint and then inserts the scanner into the docking station at that location and a record is made of the time of day, unique identification of the docking station

and fingerprint image of the security person which is stored in the scanner and then at the end of the round the security person inserts the scanner into the supervisory docking station which downloads the fingerprint images and times of day correlated with the docking station identification codes (p. 9, line 32 to p. 10, line 14).

In utilizing applicants' invention in a typical law enforcement situation, the docking station is located within the law enforcement vehicle and the scanner can be used by law enforcement personnel at locations remote from the vehicle. In utilizing applicants' invention in a typical security situation, a single scanner is carried by the security officer and a docking station is located at each checkpoint or location where the officer is to perform an inspection. Each bay station has a unique identification and there is bi-directional exchange of information between the scanner and the bay station so that the identity of the security officer can be confirmed and a record of the inspections is made which can be monitored at any time.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 1-3 and 7-9 are rejected under 35 USC 103 as being unpatentable over Tomko (5,790,668) in view of Fishbine et al. (5,467,403).

II. Claims 4, 6, 10 and 11 are rejected under 35 USC 103 as being unpatentable over Tomko in view of Fishbine et al. and further in view of Delagrange et al. (5,872,211).

III. Claim 5 is rejected under 35 USC 103 as being unpatentable over Tomko in view of Fishbine et al. and further in view of Schneider et al. (5,456,256).

ARGUMENT

I. The rejection of claims 1-3 and 7-9 under 35 USC 103 based on Tomko in view of Fishbine et al.

Contrary to the Examiner's position set forth in the Final Rejection it would not be obvious to combine Tomko and Fishbine et al. in the manner proposed, and even if the proposed combination of Tomko and Fishbine et al. were to be made it would not result in applicants' claimed invention. The "biometric input devices" shown at 20, 120 and 220 of Figure 1 and shown in further detail in Figures 2 and 3 and mentioned col. 3, lines 39-51 of Tomko do not store fingerprint images in the manner claimed in part a) of claim 1 of the instant application. An important feature of applicants' invention is that the fingerprint images obtained by the portable scanner at one location are stored in the scanner for later retrieval at a docking station at a location physically spaced from the location where fingerprint images are obtained. Claim 1 emphasizes this important and significant distinction over Tomko.

The "docking stations" shown at 28 and 30 in Figure 1 and mentioned in col. 3, lines 11-13 in Tomko receive the smart cards 140 and 240, respectively, as described in col. 3 at lines 17 and 20. They do not receive portable fingerprint scanners in the manner claimed by applicants because the biometric input devices 120 and 220 are hard-wired to docking stations 28 and 30

by lines 118 and 218, respectively (col. 3, lines 14 and 15 of Tomko).

Claim 1 in part b) calls for the docking station being physically separate from the scanner when the scanner is obtaining fingerprint images to further emphasize the foregoing significant differences as compared to the Tomko arrangement.

Thus, the Tomko arrangement is not a true mobile device as does not store the fingerprint images within the portable biometric collection unit, but requires a stationary unit to receive each biometric specimen as it is acquired and to perform matching and report back the results of the match operation. Tomko does not address a mobile system except as it applies to an entire system where the mobile unit is in constant communication with the central system.

In view of the foregoing, it would not be obvious to combine Tomko with Fishbine et al. The several significant differences between applicants' claimed system and the arrangement of Tomko preclude any motivation or incentive to make the proposed combination. The alleged advantages set forth in the Final Rejection would not apply to the proposed modification of Tomko. Tomko is concerned with preventing fraudulent enrollment or access in welfare/insurance entitlements where the individual goes to a location for enrollment and the biometric information conveniently is obtained at the same location where administration/encryption/verification occurs. There is no need and thus no motivation or incentive to modify the Tomko system to include a portable fingerprint scanner.

Furthermore, even if the proposed combination of Tomko and Fishbine et al. were to be made it would not result in applicants' claimed invention. For at least one reason, that is because the "portable image collection unit 10" of Fishbine et al. does not store fingerprint images obtained in the scanner for later retrieval by a docking station in the manner claimed by applicants. The Fishbine et al. apparatus does not store data locally but utilizes a data link to a docking station or main computer-based automatic fingerprint identification system.

To summarize, applicants' mobile fingerprint scanning and docking arrangement saves biometric data locally within the memory and data storage system contained within the mobile device. The mobile device uploads the biometric samples or templates, and other data that may come from various input including a bar code reader, upon being docked and does not require an ever-present electric or wireless connection to the docking unit. Since the images and data information is stored on the mobile unit it may represent a single finger, all ten fingers of the hand, vehicle id scanned from the registration, and may even include data from multiple persons and multiple information sources.

Applicants' invention can operate for extended periods of time without the need for a central docking station. Biometric information is merely cached locally until such time as an opportunity is available to transfer the collected data to the docking station. Neither the Fishbine et al. nor Tomko devices are capable of operation beyond the collection of a single biometric sample if they are not in direct electronic communications with the docking station. These devices operate more like a wireless computer mouse rather than a data

collection and storage device like that of applicants' invention.

Accordingly, claim 1 and dependent claims 2, 3 and 7-9 are believed to patentably distinguish over Tomko and Fishbine et al. within the meaning of 35 USC 103.

II. The rejection of claims 4, 6, 10 and 11 under 35 USC 103 based on Tomko in view of Fishbine et al. and Delagrance et al.

The rejection of claims 4, 6, 10 and 11 under 35 USC 103 based on Tomko in view of Fishbine et al. and Delagrance et al. is believed to be improper. Dependent claims 4 and 6 include all the limitations of claim 1 which, for the reasons set forth above, is believed to patentably distinguish over Tomko and Fishbine et al. Delagrance et al. is not considered to disclose anything having a bearing on the reasons why claim 1 is considered to patentably distinguish over Tomko and Fishbine et al. Furthermore, the Delagrance et al. apparatus is not a portable unit. It represents a docking station platform used as a retail terminal. A portable device communicates with the docking station to unlock it and allow its use. The mobile device is nothing more than a KEY that uses a biometric input instead of a physical key.

Regarding independent claim 10, the two docking stations 28 and 30 of Tomko receive the smart cards 140 and 240, respectively, but they do not receive portable fingerprint scanners because biometric input devices 120 and 220 are hard-wired to docking stations 28 and 30 by lines 118 and 218, respectively as pointed out hereinabove. Delagrance does not teach a plurality of docking stations having the features set forth in part (b) of claim 10 in combination with a supervisory

docking station for receiving a portable fingerprint scanner in the manner called for in part c) of claim 10.

To summarize, applicants' identification and security system saves biometric data locally within the memory and data storage system contained within the mobile device. The mobile device uploads the biometric samples or templates, and other data that may come from various input including a bar code reader, upon being docked and does not require an ever-present electric or wireless connection to the docking unit. Since the images and data information is stored on the mobile unit it may represent a single finger, all ten fingers of the hand, vehicle id scanned from the registration, and may even include data from multiple persons and multiple information sources.

Applicants' invention can operate for extended periods of time without the need for a central docking station. Biometric information is merely cached locally until such time as an opportunity is available to transfer the collected data to the docking station. Neither the Fishbine et al., Delagrange et al. nor Tomko devices are capable of operation beyond the collection of a single biometric sample if they are not in direct electronic communications with the docking station. These devices operate more like a wireless computer mouse rather than a data collection and storage device like that of applicants' invention.

In view of the foregoing, claims 4, 6, 10 and 11 are believed to patentably distinguish over Tomko, Fishbine et al. and Delagrange et al. within the meaning of 35 USC 103.

III. The rejection of claim 5 under 35 USC 103 based on Tomko in view of Fishbine et al. and Schneider et al.

Dependent claim 5 includes all the limitation of claim 1 which, for the reasons set forth above, is believed to patentably distinguish over Tomko and Fishbine et al. Schneider et al. is not considered to disclose anything having a bearing on the reasons why claim 1 is considered to patentably distinguish over Tomko and Fishbine et al.


In view of the foregoing, claim 5 is believed to patentably distinguish over Tomko, Fishbine et al. and Schneider et al. within the meaning of 35 USC 103.

CONCLUSION

The Board is respectfully requested to reverse the 35 USC 103 rejections of record, for the reasons set forth above, and find that claims 1-11 define patentable subject matter over the art of record.

Respectfully submitted,
HODGSON RUSS LLP

By



Martin G. Linihan
Reg. No. 24, 926

One M&T Plaza, Suite 2000
Buffalo, New York 14203-2391
Tel: (716) 848-1367 (direct)
DATE: September 27, 2005

CLAIMS APPENDIX

1. A fingerprint identification system comprising:
 - (a) a portable fingerprint scanner which can be hand carried to various locations for obtaining fingerprint images and for storing the images obtained in the scanner for later retrieval; and
 - (b) at least one docking station at a location spaced from the location where fingerprint images are obtained, the docking station being in the form of a receptacle for receiving the scanner, the docking station being physically separate from the scanner when the scanner is obtaining fingerprint images, the fingerprint images being downloaded from the scanner when the scanner is received in the docking system.
2. A system according to claim 1, further including a computer operatively connected to the docking station for processing fingerprint images downloaded from the scanner.
3. A system according to claim 2, wherein diagnostic routines are provided by the computer for operation on the scanner while in the docking station.
4. A system according to claim 1, wherein the scanner is battery operated and wherein the docking station is provided with a voltage source for recharging the scanner battery when in the docking station.
5. A system according to claim 1, wherein the scanner is an ultrasonic fingerprint scanner.

6. A system according to claim 1, wherein the scanner has barcode scanning capability.

7. A system according to claim 1, wherein the docking station is located in a law enforcement vehicle and wherein the scanner is adapted to be carried by a law enforcement officer.

8. A system according to claim 7, wherein the scanner is provided with an external magnetic component for attachment to a vehicle during use in obtaining images.

9. A system according to claim 1, wherein the scanner has an infrared data link for wireless transmission of fingerprint images while received in the docking station.

10. A fingerprint identification and security system comprising:

- (a) a portable fingerprint scanner which can be carried on a person and which includes a time of day clock and a port for data communication to and from the scanner;
- (b) a plurality of docking stations at locations where inspections are to be performed, each of the docking stations being in the form of a receptacle for receiving the scanner, each docking station having a microprocessor and a unique code identification, there being bidirectional data communication between the docking station and the scanner received therein; and
- (c) a supervisory docking station in the form of a receptacle for receiving the scanner for

downloading fingerprint images, times of day and docking station identifications from the scanner received therein; and

- (d) whereby when a security person makes a round when he reaches each inspection location he operates the scanner to image his fingerprint and then inserts the scanner into the docking station at that location and a record is made of the time of day, unique identification of the docking station and fingerprint image of the security person which is stored in the scanner and then at the end of the round the security person inserts the scanner into the supervisory docking station which downloads the fingerprint images and times of day correlated with the docking station identification codes.

11. A system according to claim 10, further including a computer operatively associated with the supervisory docking station for processing the downloaded fingerprint images, times of day and docking station identification codes.